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EXAMINER	
HAYES, BRET C	

ART UNIT	PAPER NUMBER
3644	

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/785,354	MORGAN ET AL.	
	Examiner	Art Unit	
	Bret C. Hayes	3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 May 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 1 – 14 is withdrawn in view of the reference(s) to US Patent Nos.: 4,026,059 to Ochs; 4,051,616 to Mathauser; 4,118,882 to Gorsky; and 5,274,943 to Ratcliffe et al. (*Ratcliffe*), as previously cited by Applicant. Rejections based on the cited reference(s) follow.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 recites the limitations "the handle section" (4X) in sections a) - (6) and (7), b) – (1), and d) – (1), and "the light bulb" (2X) in d) – (6) – (H) and (I). There is insufficient antecedent basis for these limitations in the claim. Examiner notes that "a handle end" and "a light element" have been previously recited in the claim.

5. Claim 9 recites the limitation "one or more signal devices…each mounted…", which is unclear as the recitation appears to be an attempt to make the limitation apply to only that embodiment including the "more" than one signal device portion of the metes and bounds of the claim. For example, "one signal device" is incongruous with the term "each" in this recitation.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mathauser in view of Ochs in view of Ratcliffe.

8. Re – claim 1, Mathauser discloses the claimed invention including a fishing rod comprising:

a) a body unit **10** which includes

(1) a distal end having a tip **46**,

(2) a handle end **14** being hollow and having a handle chamber, containing power source **96**, defined therein, see Fig. 1, for example,

(3) a body longitudinal axis extending between the distal end and the handle end **14**,

(4) a wall extending between the distal end and the handle end **14**, said body unit **10** being flexible with respect to the body longitudinal axis between a flexed configuration and an un-flexed configuration, see Figs. 1 and 2, for example,

(5) a signal section **12** between the distal end and the handle end **14**, the signal section including

(A) a translucent wall section, see col. 4, lines 44 – 57, for example, which includes a statement regarding the rod being formed of glass, which is translucent,

(B) a hollow bore, which extends in the direction of the body longitudinal axis,

(C) a chamber in the hollow bore—a hollow bore defines a chamber,

(D) a first end, at **160**,

(E) a second end, at the distal end of the rod **12**, spaced from the first end of the signal section in the direction of the body longitudinal axis,

(F) a first wall at **160** and **180**, on the first end of the signal section, and

(G) a second wall, the inner wall of the rod itself, on the second end of the signal section,

(6) a reel section **16** and **18** located between the handle end **14** and the signal section, see Figs. 1 and 2, for example, and

(7) said body unit being hollow between the handle end and the signal section;

b) a power system which includes

(1) a battery section defined in the wall **72** of said body unit **10** and which includes an opening through the wall **72** of said body unit in the handle end **14** of said body unit, and

(2) a battery **96** releasably mounted, at **94**, on the wall **72** of said body unit adjacent to the opening of the battery section, see Figs. 1 and 2, for example;

c) a light element **76**;

d) a light control system which includes

(1) a main on/off switch **80**, **82** section defined in the wall **72** of said body unit **10** and which includes an opening through the wall **72** of said body unit **10** in the handle end

14 of said body unit **10**, the main on/off switch section being spaced apart from the battery section in the direction of the longitudinal axis of said body unit **10**, see Figs. 1 and 2, for example,

(2) a main on/off switch **80**, **82** mounted on the wall **72** of said body unit **10** adjacent to the opening of the main on/off switch section, the main on/off switch being movable between an "on" configuration and an "off" configuration and having a switch lever located outside the chamber defined in the handle end **14** of said body unit **10**, see Figs. 1 and 2, for example,

(3) a first electrical conductor electrically connecting the battery to ground, see Figs. 1 and 2, for example,

(4) a second electrical conductor electrically connecting the battery to the main on/off switch, see Figs. 1 and 2, for example,

(5) a third electrical conductor electrically connected to the main on/off switch, see Figs. 1 and 2, for example,

(6) an activation switch **142**, **144**, **158**, **160** located in the signal section **12** of said body unit **10** and including

(A) a mounting bore, as at **174** – the 'bore' being the actual hole itself – defined in the first wall **180** of the signal section **12** and which extends in the direction of the body longitudinal axis,

(B) a mounting tube **174** – the 'tube' being the portion extending beyond the wall **180**, for example, in the mounting bore and which includes a proximal

end, to the left of **180**, in the mounting bore and a distal end located outside of the mounting bore, see Figs. 1 and 2, for example,

(C) an electrically conductive pin **158** fixedly mounted in the mounting tube **174** and which includes a distal end **190** that is located outside of the mounting tube **174**, the electrically conductive pin **158** having an outer diameter, see Figs. 1 and 2, for example,

(D) the third electrical conductor electrically connecting the electrically conductive pin **158** to the main on/off switch **80**, **82**,

(E) a coil spring located in the signal section **176** and which includes

(i) a first end fixedly mounted on the first wall **160**, **180** of the signal section **12**,

(ii) a second end spaced from the first end of the coil spring **176** in the direction of the body longitudinal axis,

(iii) a spring bore defined between the first end of the coil spring and the second end of the coil spring, and

(iv) the coil spring being electrically conductive,

(F) the coil spring **176** being mounted to surround the electrically conductive pin **158** with the electrically conductive pin **158** being located in the spring bore and extending from adjacent to the first end of the coil spring **176** toward the second end of the coil spring **176**,

(G) the coil spring **176** having a diameter measured at the spring bore, the diameter of the coil spring **176** being greater than the outer diameter of the

electrically conductive pin **158** with the electrically conductive pin **158** being spaced apart from the coil spring **176** when said body unit **10** is in the unflexed configuration,

(H) a fourth electrical conductor electrically connecting the light element **76** to the coil spring, see Figs. 1and 2, for example,

(I) a fifth electrical conductor electrically connecting the light element to ground; and

e) wherein the light element is activated by flexing of the electrically conductive pin and the coil spring relative to each other whereat electrical contact is made therebetween when the fishing rod is in any orientation including vertically upward.

Regarding passage a), (5), (A), a translucent wall section being translucent, Mathauser discloses contemplating the use of glass to form the rod. Ochs teaches a transparent or translucent fishing rod made compacted glass fibers, as in the Abstract, for example, in the same field of endeavor for the purpose of transmitting light. Since Ochs predates the disclosure of Mathauser, it would imply that Mathauser indeed contemplates an embodiment having a translucent wall section as claimed. In any event, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mathauser to include a translucent wall section as taught by Ochs in order to transmit light.

Mathauser does not disclose the light element **76** being mounted on the first wall **160, 180** of the signal section **12**. Ochs further teaches a light element **26** in the signal section **11, 23** being mounted on the first wall of the signal section **23**, see Figs. 1 – 4, for example, in the same field of endeavor for the purpose of more easily seeing the light of the lighted fishing rod. It

would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mathauser to mount the light element in the first wall of the signal section as taught by Ochs in order to more easily see a light.

9. Regarding d), (6), (A) and (B), a mounting bore and mounting tube, while it may be arguable that Mathauser does not disclose such, it is well-settled case law that it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the tube **174** as a separate piece extend *through a bore*, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. In this case, the intention of Mathauser is clear – to have a mounting tube **174**, which either integrally or separately would include a bore, through the wall section **180**.

Mathauser further does not disclose the coil spring **176** being sized and located with respect to the electrically conductive pin **158** to be in electrical contact with the electrically conductive pin **158** when the body unit **10** is in the flexed configuration. Ratcliffe teaches a coil spring **74** located in the signal section **30** being sized and located with respect to the electrically conductive pin **84** to be in electrical contact with the electrically conductive pin **84** when the body unit **20** is in the flexed configuration in the same field of endeavor for the purpose of indicating a strike on the fishing rod. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mathauser to have the coil spring be sized and located with respect to the electrically conductive pin to be in electrical contact with the electrically conductive pin when the body unit is in the flexed configuration as taught by Ratcliffe in order to indicate a strike on a fishing rod.

Regarding the plethora of electrical conductors electrically 'connecting' as claimed, Mathauser shows the conductors electrically connecting via circuit board **122**, for example.

10. Re – claim 2, Mathauser discloses the device as claimed as outlined above. Further, Mathauser discloses a translucent section between the handle section **14** and the tip section **46**, set forth at col. 4, lines 44 – 57, for example, which describes the fishing rod as being made of glass, which is transparent and translucent, a light **76**. However, Mathauser does not disclose the light **76** being located in the translucent section. Ochs teaches a light **26** in a translucent section **11, 23**, as above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mathauser to have the light be in a translucent section as taught by Ochs for the purpose indicated above.

Further, Mathauser does not disclose a third electrical conductor electrically connecting the coil spring to the light. Ratcliffe teaches a third electrical conductor electrically connecting a coil spring **76** to a light **50**, see Figs. 1 – 7, for example, in the same field of endeavor for the purpose outlined above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mathauser to have a third electrical conductor so connected as taught by Ratcliffe as reasoned above.

Further, Mathauser does not disclose the coil spring and the electrically conductive pin being sized and positioned with respect to each other so the electrically conductive pin is in electrical contact when the flexible body is in the flexed configuration and the electrically conductive pin is electrically spaced apart from the coil spring when the flexible body is in the unflexed configuration. Ratcliffe teaches a coil spring **76** and an electrically conductive pin **84** being sized and positioned with respect to each other so the electrically conductive pin **84** is in

electrical contact with the coil spring **76** when the flexible body is in the flexed condition and the electrically conductive pin **84** is electrically spaced apart from the coil spring **76** when the flexible body is in the unflexed condition in the same field of endeavor for the purpose of making the device more efficient and practical as the light is not continuously on. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mathauser to have such as taught by Ratcliffe in order to make the device more efficient.

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gorsky in view of Ratcliffe.

12. Re – claim 4, Gorsky discloses the invention substantially as claimed including a kit for retrofitting an existing fishing rod having a rear portion and a flexing portion movable between a flexed condition and an unflexed condition, the kit comprising:

a) a first container **101** mountable on said rear portion of said fishing rod **104**;

b) a second container **105, 111** mountable on said flexing portion of said fishing rod **104**, see Fig. 1, for example;

c) a translucent section **47** in said first container **101**, as set forth at col. 2, lines 17 – 24;

d) a light **45** in said translucent section **47**;

e) a battery, as set forth at col. 2, lines 17 – 24;

f) a main on/off switch **48** in said first container **101**;

g) an activation switch located in said second container **105, 111** and which includes

(1) an electrically conductive pin **4**, and

h) an electrical conductor system which includes

(1) a first electrical conductor electrically connecting said battery to ground,

(2) a second electrical conductor electrically connecting said battery to said main on/off switch, see Fig. 1 – 7, and col. 1 and 2, for example.

13. However, Gorsky does not disclose an electrically conductive coil spring surrounding the electrically conductive pin **4**. Ratcliffe teaches an electrically conductive coil spring **76** surrounding and electrically conductive pin **84** in the same field of endeavor for the purpose of creating a flexing-actuated lighted fishing strike indicator. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gorsky to include that as taught by Ratcliffe in order to make a flexing-actuated fishing strike indicator.

14. Further, Gorsky does not disclose

(3) a third electrical conductor electrically connecting said main on/off switch to said electrically conductive pin,

(4) a fourth electrical conductor electrically connecting said coil spring to said light, and

(5) a fifth electrical conductor electrically connecting said light to ground; and wherein said coil spring and said electrically conductive pin are sized and positioned with respect to each other so said electrically conductive pin is in electrical contact

i) with said coil spring when said flexing portion of said rod is in the flexed condition and the electrically conductive pin is electrically spaced apart from said coil spring when said flexing portion of said rod is in the unflexed condition; and

j) wherein the light is activated by flexing of the electrically conductive pin and the electrically conductive coil spring relative to each other whereat electrical contact is

made therebetween when the fishing rod is in any orientation including vertically upward.

15. Ratcliffe teaches an electrical conductor connecting the coil spring **76** to the light **50** in the same field of endeavor for the purpose of wiring the device so as to function as designed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gorsky to include that as taught by Ratcliffe in order to make the device operate as intended. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to multiply the electrical conductors and rearrange the wiring of the device as necessary, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art [*St, Regis Paper Co. v. Bemis Co.*, 193 USPQ 8], and since it has been held that rearranging parts of an invention involves only routine skill in the art [*In re Japiske*, 86 USPQ 70].

16. Re – claims 5 – 9, see above rejection based upon US Patent Nos.: 4,026,059 to Ochs; 4,051,616 to Mathauser; 4,118,882 to Gorsky; and 5,274,943 to Ratcliffe et al. (*Ratcliffe*).

17. Re – claims 5 – 8, the invention is disclosed or obviated above using a light as a signal device. The substitution of any other well-known signal device, such as a sound-producing device, a vibration-producing device, or an electric-shock producing device, would be obvious variants of the disclosed invention as applied above, since the equivalence of a light as a signal device and any of the aforementioned devices for their use in the signaling art and the selection of any known equivalents to a light would be within the level of ordinary skill in the art.

18. Re – claim 9, see rejection of claim 1 above. Mathauser discloses 'one or more signal devices from the set comprising a light-emitting element, a sound-emitting element and a vibratory element' as claimed.

Conclusion

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (571) 272 – 6902. The examiner can normally be reached Monday through Friday from 5:30 am to 3:00 pm, Eastern Standard Time.

On July 15, 2005, the Central FAX Number will change to **571-273-8300**. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and **571-273-8300** will be the only facsimile number recognized for "centralized delivery".

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu, can be reached at (571)272 – 7045. The fax number is (703) 872 – 9306.

bh

22-Jul-05

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